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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,706	05/01/2002	Stefan Kastner	VAW-6	1805
21890	7590	09/13/2005	EXAMINER	
PROSKAUER ROSE LLP PATENT DEPARTMENT 1585 BROADWAY NEW YORK, NY 10036-8299			COZART, JERMIE E	
			ART UNIT	PAPER NUMBER
			3726	

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/019,706

**Applicant(s)**

KASTNER, STEFAN

**Examiner**

Jermie Cozart

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/30/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 6, 11-14, 16, and 17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kawase et al. (4,172,923).

Kawase discloses producing an aluminum composite material by cutting at least one cladding layer of a specified thickness suitable for use as a cladding sheet layer from a first ingot made from a first aluminum material, then placing then cladding laver on a side of a second ingot made from a second aluminum material, and rolling the cladding layer and the second ingot, the rolling comprises several roll passes thereby producing the aluminum composite material. The cladding sheet layer has a thickness of 5mm after cutting, and at least one surface of the cladding layer and the second ingot are treated prior to rolling by being degreased with trichloroethylene. *See column 5, line 37 – column 6, line 40 for further clarification.*

Kawase discloses producing at least one aluminum cladding layer from a first ingot made from a first aluminum material, the cladding layer for use in an aluminum composite material, the composite material being produced at least partially by (1) placing the cladding layer on a side of a second ingot made from a second aluminum material, and (2) rolling the cladding laver and the second ingot, the rolling comprising

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several roll passes thereby producing the composite material. The aluminum cladding layer is cut from the first ingot at a specified thickness suitable for use as a cladding sheet for the composite material. *See column 5, line 37 – column 6, line 40 for further clarification.*

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7-10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawase et al. (4,172,923) in view of Ronan (2,730,792).

Kawase as described in detail above discloses all of the claimed subject matter except for the cutting comprising sawing the cladding layer from the first ingot.

Ronan discloses a metal saw use for cutting metal and consequently cutting through a metal work-piece, in order to prevent damage to the work-piece and provide a straight cut through the work-piece. *See columns 1-3, and figures 1-8 for further clarification.*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to cut the cladding layer of Kawase from the first ingot by using a saw, in light of the teachings of Ronan, in order to effectively prevent damage to the ingot, and provide an accurate cut through the ingot.

***Response to Arguments***

5. Applicant's arguments filed 6/27/05 have been fully considered but they are not persuasive.

Applicant argues that Kawase does not disclose that the cladding layer of specified being cut from a first ingot, and not from a hot-rolled sheet.

In response, the Examiner maintains that the ingot is heat treated and rolled into a sheet, and then a cladding layer is cut from the sheet, so therefore the cladding layer is cut from the ingot. The method steps of the claims in question do not specify that ingot must not be treated prior to being cut. Note that "The transitional term 'comprising', which is synonymous with 'including,' 'containing,' or 'characterized by,' is inclusive or open-ended and does not exclude additional, unrecited elements or method steps." See MPEP 2111.03 for further clarification.

Applicant argues that there is not disclosure or suggestion in either Ronan or Kawase for cutting a cladding layer from a first ingot using the saw defined by Ronan.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Kawase clearly discloses that a cladding layer is cut. Kawase, however, is silent with respect to the device for performing the cutting operation. Ronan discloses a metal cutting saw for cutting metal material, in order to provide a straight cut without damaging the work-piece. Therefore, it would have been obvious to one having ordinary skill in the art to

use saw of Ronan to cut the cladding layer of Kawase, in order to provide a straight cut without damaging the work-piece.

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jermie Cozart whose telephone number is 571-272-4528. The examiner can normally be reached on Monday-Thursday, 7:30 am - 6:00 pm.

8. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Bryant can be reached on 571-272-4526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**David P. Bryant**  
Primary Examiner



JC  
September 8, 2005